

U.S. Application No. 09/965,030
Reply to Office Action dated October 28, 2005

PATENT
450100-03503

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance. The present amendment is being made to facilitate prosecution of the application.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-3, 5-7, and 9-11 are currently pending. Claims 4, 8, and 12 are hereby canceled, without prejudice or disclaimer of subject matter. Claims 1, 5, and 9, which are independent, are hereby amended. No new matter has been introduced by this Amendment.

Changes to claims are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 1-3, 5-7, and 9-11 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,643,702 to Yeung (hereinafter, merely "Yeung") in view of U.S. Patent No. 6,636,922 to Bastiani et al. (hereinafter, merely "Bastiani").

Claims 4, 8, and 12 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Yeung and Bastiani and further in view of U.S. Patent No. 6,728,244 to Takabatake (hereinafter, merely "Takabatake") and further in view of U.S. Patent No. 6,693,915 to Lappetelainen et al. (hereinafter, merely "Lappetelainen").

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Applicants respectfully traverse the rejection because there is no motivation, either in the references themselves, nor in one of ordinary skill in the art, to combine Yeung with Bastiani, and then combine that combination with Takabatake and further combine it with Lappetelainen.

Claim 1 recites, *inter alia*:

"... wherein the data transfer apparatus is formed of an IEEE-1394 bridge conforming to the BRAN specification." (Emphasis added)

As understood by Applicants, Yeung relates to a method for initializing an eligibility bit map and determining whether at least one eligible route has required resources available.

As understood by Applicants, Bastiani relates to a host controller for enabling communication between a host computer and a device over a serial link.

As understood by Applicants, Takabatake relates to a communication node for enabling internetworking of a first network in which data transfer is based on a combination of request and response and a second network in which data transfer is not based on a combination of request and response.

As understood by Applicants, Lappetelainen relates to efficient bandwidth allocation for a high speed wireless data transmission system.

Applicants respectfully submit that there is no motivation to combine Yeung, Bastiani, Takabatake and Lappetelainen. M.P.E.P. §2145.01 states:

There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teachings. The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of

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suggestion in the prior art of the desirability of combining references. (Emphasis added)

Applicants respectfully submit that there is no motivation in the prior art of record to modify an IEEE-1394 bus conforming to the BRAN specification to create the data transfer apparatus recited in claim 1. Indeed, the Specification teaches on pages 1-9 the specific problems in the prior art IEEE-1394 bus. The Specification states:

"Therefore, when an asynchronous packet is sent to a destination which is not connected on the network, it is not reported to the transmission source that the packet is an error packet and acknowledgement is not returned. The transmission source may repeat meaningless retransmission." (See page 9 of the Specification.)

Applicants respectfully submit that nothing has been found in either Yeung, Bastiani, Takabatake or Lappetelainen, taken alone or in combination, nor in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings in such a way as to create the data transfer apparatus of claim 1, which significantly improves the IEEE-1394 bus conforming to the BRAN specification.

Additionally, Applicants respectfully submit that the Office Action can **not** rely on impermissible hindsight reasoning in seeking a motivation to combine the reference teachings. More specifically, M.P.E.P. §2142 states:

To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. **In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person.** Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. **The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult**

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to avoid due to the very nature of the examination process.
However, impermissible hindsight must be avoided and the
legal conclusion must be reached on the basis of the facts
gleaned from the prior art. (Emphasis added)

Although a hindsight point of view is necessary to develop an understanding of applicants' invention, it may take "into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made" (MPEP §2145). Nothing has been found within the knowledge within the level of ordinary skill in the art at the time the invention was made, to motivate a person of ordinary skill in the art to combine the reference teachings to create the data transfer apparatus as claimed in claim 1.

Therefore, Applicants respectfully submit that claim 1 is patentable.

For reasons similar to, or somewhat similar to, those described above with regard to independent claim 1, independent claims 5 and 9 are also patentable.

Therefore, Applicants respectfully submit that independent claims 1, 5 and 9 are patentable.

III. DEPENDENT CLAIMS

The other claims are each dependent from one of the independent claims, discussed above, and are therefore patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

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CONCLUSION

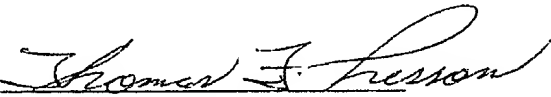
In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited reference, or references, it is respectfully requested that the Examiner specifically indicate those portions of the reference, or references, providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are in condition for allowance and Applicants respectfully request early passage to issue of the present application.

Respectfully submitted,

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